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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/169,705 12/17/93 HELLMUTH

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EXAMINER

DUDEK, J

E5M1/0822

ART UNIT

PAPER NUMBER

4

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2515

DATE MAILED: 08/22/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 2 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-17 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims 15 are allowed.

4. Claims 1-14, 16-17 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit: 2515

Part III DETAILED ACTION

Information Disclosure Statement

The reference lined through in the Information Disclosure Statement has not been considered because the lined through reference does not contain a date of publication.

Drawings

1. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the linear polarizing means of claims 10-11 and the fixation target of claims 12-14 must be shown or the feature cancelled from the claim. No new matter should be entered.
2. The drawings are objected to as failing to comply with 37 CFR § 1.84(f) which states, "The same character must never be used to designate different parts." However, "402" has been used to designate both a beamsplitter and a mirror in figure 6. Correction is required.

Specification

3. The title of the invention is not sufficiently descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

4. Claims 1-14 and 16-17 are objected to because of the following informalities: the term "the fundus by the eye" should be the fundus of the eye. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 16-17 the term "a scanned sample beam of radiation" is indefinite because a beam of radiation cannot be scanned. The term "which apparatus comprises" is confusing. The term "a lens means which is fixed with respect to the beam scanner" is indefinite because it is not clear how the lens and beam scanner are fixed, i.e. the distance or angle could be fixed.

In claim 5 the term "a scanned sample beam of radiation" is indefinite because a beam of radiation cannot be scanned. The term "which apparatus comprises" is confusing. The term "the means for transferring is fixed with respect to the beam scanner and at least a first portion of the focusing means" is indefinite because it is not clear how the lens and beam scanner are fixed, i.e. the distance or angle could be fixed.

Claims 2 and 6 are indefinite because they fails to cite the necessary limitations needed to make clear the interrelation between the means for focusing and the fundus camera and the ocular (or the internal lens).

Claims 8 and 9 are indefinite because they fail to cite the necessary limitations needed to make clear the interrelation between the light stop means and the illumination path.

Claims 10 and 11 are indefinite because they fail to cite the necessary limitations needed to make clear the interrelation between the linear polarizing means and the observing path and the

Art Unit: 2515

illumination path. The term "the illumination means" lack proper antecedent basis.

In claim 12 the term "the ocular lens" lacks proper antecedent basis.

The interrelation of the limitation of claim 14 and the apparatus is not clear.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-7 and 16-17 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Klingbeil et al. (39 26 652).

Klingbeil et al. discloses an apparatus comprising:

a. a scanning sample beam of radiation;
b. beamsplitter for transferring the sample beam (13);
c. a focusing means (1) which is fixed with respect to the beam scanner, i.e. rotatable lens 1 stays in the same plane, therefore the lens and the mirror of the scanner (which does not have a reference number) are fixed, also the first portion is 1 and 2 where 1 is fixed and 2 is moveable; and

d. an ocular lens of a fundus camera (2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2515

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

9. Claims 12-14 are rejected under 35 U.S.C. § 103 as being unpatentable over Klingbeil et al. Klingbeil et al. discloses the claimed invention except for the fixation means. Since it is notoriously well known in the art to incorporate a fixation means in an ophthalmic device, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Klingbeil et al. with a fixation means in order to provide an image for the patient to focus on during the scanning process.

10. Claims 4 and 8-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Klingbeil et al. in view of Kobayashi (4,900,144). Klingbeil et al. discloses the claim invention except for the compensator and light stop means. Kobayashi teaches it was known to

Art Unit: 2515

use a compensator in fundus illuminating apparatus (see 26 of figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the light blocking means of Kobayashi in the apparatus of Klingbeil et al. in order to prevent the center the ocular lens from illuminating.

Regarding the compensating means, Kobayashi teaches it was known to use a compensator in a fundus illuminating apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the compensator of Kobayashi in the apparatus of Klingbeil et al. in order to compensate for the phase shift in the light because of the beamsplitter.

Allowable Subject Matter

11. Claims 10 and 11 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

12. Claim 15 is allowable over the prior art of record.

13. The following is an Examiner's statement of reasons for the indication of allowable subject matter: regarding claim 15 the prior art of record teaches the claimed invention except for the reference beam and sample beam impinging direction being disposed at an angle of 45 degrees.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Dudek whose telephone number is (703) 308-4093.

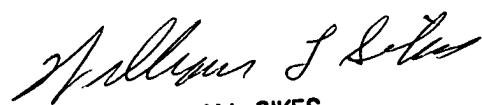
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Serial Number: 08/169,705

-7-

Art Unit: 2515

Papers related to this application may be submitted to Art Unit 2515 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Art Unit 2515 fax number is (703) 308-7725.



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